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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,729	11/12/2003	Peter Baumann	BAUMANN ET AL. - 2 (PCT)	7258
25889	7590	12/28/2004	EXAMINER	
WILLIAM COLLARD COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			SAVAGE, MATTHEW O	
			ART UNIT	PAPER NUMBER
			1724	

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/706,729

Applicant(s)

BAUMANN ET AL.

Examiner

Matthew O Savage

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 26-39 is/are pending in the application.
- 4a) Of the above claim(s) 30-35, 38 and 39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-29, 36 and 37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 10/111473.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Applicant's election with traverse of species P2 and R1 in the reply filed on 10-28-04 is acknowledged.

Applicant's argument that claim 30 reads on species P2 is not agreed with since there is no disclosure of the pin of the species P2 (FIG. 5) being mounted in a radially flexible manner. Applicant should not e that the first full paragraph on page 15 is directed to species P5 (FIG. 9) as opposed to P2.

Applicant's argument that claim 31 reads on species P2 is not agreed with since the contact zone of the species P2 is rounded as opposed to being tapered and is formed on the free end 40 of the projection 39 as opposed to the free end of the pin.

Applicant's argument that species P2 includes a contact zone in the form of a spot or line as recited in claim 32 is also not agreed with since FIG. 5 clearly shows an elongated contact zone as opposed to a spot or line. Applicant should note that contact zones in the form of a spot or line are limited to those of species P3 and P4 (FIGS. 7 and 8, see the first two paragraphs of page 13).

Applicant argument that claim 33 reads on species P2 is not agreed with since there is no disclosure of the species P2 (FIG. 5) having a "rounded or inclined flank". It is contended that claim 33 corresponds to species P3 and P4 as opposed to P2 (see the paragraph bridging pages 12 and 13).

Applicants argument that claims 34 and 35 read on species P2 (FIG. 5) is false since the pin of species P2 is not axially adjustable as in the case of species P4 (FIG. 8).

Applicant's argument that claims 36-39 correspond to species P2 (FIG. 5) is not agreed since the species of retaining pins (P1-P5) is separate and distinct from the species of retaining means (R1-R4).

Applicant's argument that claims 26-39 correspond to specie R1 is false since only claim 37 includes the inner frame with retaining means of species R1.

Applicant argues that a search of all of the species in a single application would not impose an undue burden upon the examiner, however, it is held that a search five species of pin arrangements, four species of retaining means, and various combination and permutations thereof would impose an undue burden upon the examiner. It is noted that claims to all of the species would be considered in the case that a generic claim is found allowable.

The requirement is still deemed proper and is therefore made FINAL.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 26-29 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 3903675 A1 to Gebert et al.

With respect to claim 26, Gebert et al disclose a ring shaped insert having a pin 11 that projects eccentrically and runs parallel to a longitudinal axis of the filter insert and is integrally molded on a lower end disk of the filter insert, and a projection (e.g., the

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lower tapered portion of the pin) extending axially away from the pin and being formed on an end of the pin, the projection forming a contact zone (e.g., a tapered contact zone).

As to claims 26-29, the limitations to the filter housing fail to carry patentable weight since the filter housing has not been positively claimed.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gebert et al in view of Baumann et al.

With respect to claim 36, Gebert et al disclose a retaining means for mounting the insert on a cover of the filter housing for rotational movement of the insert about its longitudinal axis and for securing the insert axially on the cover, however, Gebert et al fail to specify the retaining means as extending axially and radially in an interior space of the insert. Baumann et al disclose a retaining means 65 extending axially and radially in an interior space 24 of an insert 6 for mounting the insert on a cover of the filter housing for rotational movement of the insert about its longitudinal axis and for securing the insert axially on a cover 7 and suggests that such an arrangement reduces the cost of replacing the insert since the cover can be re-used. It would have been obvious to

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have modified the filter of Gebert et al so as to have included the retaining means as suggested by Baumann et al in order to reduce the cost of replacing the filter insert.

Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gebert et al in view of Neufeld et al.

With respect to claim 37, Gebert et al disclose retaining means for mounting the insert on a cover of the filter housing for rotational movement on the insert about its longitudinal axis but fail to specify an inner frame comprising the means. Neufeld et al disclose an inner frame 23 including a retaining means 118 for mounting an insert 26 on a cover 24 of a filter housing for rotational movement on the insert about its longitudinal axis and for securing the insert axially on the cover and suggests that such an arrangement reduces the cost of replacing the insert since the cover can be re-used. It would have been obvious to have modified the filter of Gebert et al so as to have included the retaining means as suggested by Neufeld et al in order to reduce the cost of replacing the filter insert.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew O Savage whose telephone number is (571) 272-1146. The examiner can normally be reached on Monday-Friday, 7:00am-3:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on (571) 272-1166. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*M. Savage*  
Matthew O Savage  
Primary Examiner  
Art Unit 1724

mos  
December 23, 2004